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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/531,852

09/26/2005

Giorgio Bonmassar

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EXAMINER

NATNITHADHA, NAVIN

ART UNIT

PAPER NUMBER

3735

NOTIFICATION DATE

DELIVERY MODE

06/10/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

pat-dept@quarles.com

Office Action Summary	Application No. 10/531,852	Applicant(s) BONMASSAR ET AL.	
	Examiner NAVIN NATNITHITHADHA	Art Unit 3735	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-99 is/are pending in the application.
- 4a) Of the above claim(s) 1-13,69-79 and 91-99 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-68 is/are allowed.
- 6) ☒ Claim(s) 80-90 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20050418</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. According to the Amendment, filed 19 February 2010, the status of the claims is as follows:

Claims 14, 18, 26, 30, 40, 44, 55, 59, 80, 82, 86, and 88-90 are currently amended;

Claims 15-17, 19-25, 27-29, 31-39, 41-43, 45-54, 56-58, 60-68, 81, 83-85, and 87 are as originally filed; and

Claims 1-13, 69-79, and 91-99 are withdrawn.

Election/Restrictions

2. Applicant's election without traverse of Group II, claims 14-68 and 80-90 in the reply filed on 19 February 2010 is acknowledged.

Claims 1-13, 69-79, and 91-99 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

This application contains claims 1-13, 69-79, and 91-99 drawn to an invention nonelected without traverse filed on 19 February 2010. A complete reply to the Final Rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 80-90 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim(s) 80-90 are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter because these claims are method or process claims that do not transform underlying subject matter (such as an article or materials) to a different state or thing, nor are they tied to a particular machine. *See Diamond v. Diehr*, 450 U.S. 175, 184 (1981) (quoting *Benson*, 409 U.S. at 70); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978) (citing *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). *See also In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008), where the Fed. Cir. held that method claims must pass the "machine-or-transformation test" in order to be eligible for patent protection under 35 USC 101.

The claims do not pass the "machine-or-transformation test" because, although a machine, i.e. electrodes, is recited, the use of the particular machine does not impose a meaningful limit on the claim's scope. Moreover, the use of the particular machine does not involve more than insignificant extra-solution activity. Instead, the use of the particular machine, i.e. electrodes, is used for mere data gathering.

Examiner suggest inserting language directed to a particular machine that imposes a meaningful limit on the claim's scope, i.e. a machine that involve more than a field of use limitation and involve more than insignificant extra-solution activity.

Allowable Subject Matter

4. Claims 14-68 are allowed.
5. Claims 80-90 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 101, set forth in this Office Action.
6. The following is a statement of reasons for the indication of allowable subject matter:

As to Claims 14-68 and 80-90, the prior art of record does not teach the apparatus and method of claims 14, 26, 40, 55, 80, and 86, including: detecting an abnormality within the subject by generating continuous, real time internal impedance data that indicates an impedance change within the at least one portion of the subject, wherein the impedance change is associated with at least one of: a change in at least one characteristic of a blood vessel within the subject, and a presence of a foreign object within the at least one portion of the subject.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The other patents cited in the PTO-892 teach subject matter related to the Applicant's claims. The Examiner suggests reviewing these patents before responding to the present Office Action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NAVIN NATNITHITHADHA whose telephone number is (571)272-4732. The examiner can normally be reached on Monday-Friday, 9:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II can be reached on (571) 272-4730. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3735

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Navin Natnithithadha/
Patent Examiner, Art Unit 3735
06/07/2010